

ESTTA Tracking number: **ESTTA317902**

Filing date: **11/19/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92051532
Party	Plaintiff PictureCode, LLC
Correspondence Address	Katherine Klammer Madianos 3606 Enfield Road Austin, TX 78703 UNITED STATES katherine@madianoslaw.com
Submission	Opposition/Response to Motion
Filer's Name	Kenneth G. Parker
Filer's e-mail	kparker@tlpfirm.com
Signature	/Kenneth G. Parker/
Date	11/19/2009
Attachments	Brief Regarding Motion to Extend.pdf (11 pages)(31395 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 3,321,797
Mark: DIGITAL NINJA
Issued: October 23, 2007

PICTURECODE, LLC,

Petitioner,

v.

JUAN B. MELENDEZ III

Respondent

Cancellation No. 92051532

**PETITIONER'S NOTICE OF
MOOTNESS OF RESPONDENT'S
MOTION FOR EXTENSION OF
TIME TO ANSWER; STATEMENT
CORRECTING FACTUAL
MISSTATEMENTS MADE IN
RESPONDENT'S MOTION TO
EXTEND TIME FOR ANSWER**

TO ALL PARTIES AND THE BOARD:

PLEASE TAKE NOTICE that PictureCode, LLC hereby submits this Notice of Mootness of Respondent's Motion for Extension of Time to Answer; Statement Correcting Factual Misstatements Made in Respondent's Motion to Extend Time For Answer (this "Statement"). This Statement is based on this notice, the attached Memorandum, the attached Declaration of Katherine Klammer Madianos, the papers on file in this matter, the documents on file regarding the DIGITAL NINJA registration, and such other matters as the Trademark Trial and Appeal Board properly considers.

Dated: November 19, 2009

Respectfully Submitted,

/Kenneth G. Parker/
Kenneth G. Parker, Esq.
Teuton, Loewy & Parker LLP
3121 Michelson Drive, Suite 250
Irvine, CA 92612
949-442-7100; Fax 949-442-7105
kparker@tlpfirm.com

Katherine Klammer Madianos, Esq.
Attorneys for Petitioner

MEMORANDUM

I. INTRODUCTION

Given that Respondent has filed an Answer to Petitioner's Petition to Cancel, his Motion to Extend Time For Answer to Petition to Cancel (the "Motion to Extend") is now moot and in any case should be denied on the merits. However, Respondent has made a number of inaccurate and misleading statements in his Motion to Extend that warrant correction, as detailed below.

II. THE MOTION TO EXTEND IS MOOT BECAUSE RESPONDENT ANSWERED

As the Board is aware, Respondent submitted his Answer to the Petition to Cancel via ESTTA on October 9, 2009. Respondent clearly does not need additional time to prepare and file his answer. Thus, the Board should deny the Motion to Extend as moot.

III. FACTUAL CORRECTIONS

Respondent made several factual misstatements in his motion. Petitioner corrects these misstatements to guard against the misstatements being used against Petitioner as this proceeding moves forward.

A. The Petition to Cancel Was Delivered to Respondent's Former Attorney.

In his Motion to Extend, Respondent states that his former attorney, Mr. Thomas Chan, "asserts he never received a copy of the Petition to Cancel from the

Petitioner's Attorney..." To the contrary, Petitioner sent copies of the Petition to Cancel to Mr. Chan at the following verified postal and email addresses:

1. On October 1, 2009, as set forth in the Certificate of Service attached to the Petition to Cancel filed via ESTTA with the TTAB, Ms. Madianos deposited a copy of the Petition to Cancel with the U.S. Postal Service for delivery to Mr. Chan at the following address: P.O. Box 79159, Los Angeles, CA 90079-0159, the mailing address set forth on Mr. Chan's firm website (www.chanlaw.com). See the November 19, 2009 Declaration of Katherine Klammer Madianos attached hereto (the "Madianos Declaration") paragraphs 2, 9. This copy of the Petition was delivered to said address on October 5, 2009, and signed for by "T CHAN." *Id.*

2. On October 1, 2009, Ms. Madianos sent a copy of the Petition to Cancel to Mr. Chan at thomas.chan@chanlaw.com. Madianos Declaration paragraph 11. Ms. Madianos had received email correspondence from Mr. Chan using this email address in the past, and received no indication that her email attaching the Petition was not delivered properly. *Id.*

Thus, Mr. Chan received not one, but two copies of the Petition to Cancel in a timely manner. And, as Respondent acknowledged in his Motion to Extend, as of the October 1, 2009 delivery of the Petition to Mr. Chan by email (the date on which Mr. Chan filed a Section 7 Request to Amend the DIGITAL NINJA registration via TEAS on behalf of Respondent), Mr. Chan was Respondent's "attorney of record."

B. Petitioner Included a Certificate of Service as to Service on Respondent's Attorney with the Petition to Cancel as Filed.

In addition, Respondent states in his Motion to Extend that “there is no Certificate of Record for the Petition to Cancel as having been sent to Mr. Chan.” Presumably Respondent is referring to a Certificate of Service. As stated above, a Certificate of Service as to the service described in section III.A.1 above was attached to the Petition to Cancel as filed. Madianos Declaration paragraphs 2, 9.

C. The October 12, 2009 Certificate of Service Filed by Petitioner's Attorney Was Not “False.”

In his Motion to Extend, Respondent states as follows: “By the Petitioner’s Attorney (sic) own admission, she filed a false Certificate of Correspondence on October 12, 2009 stating the Petition to Cancel had been delivered, solely to Juan B. Melendez III.”

As the Board is aware, when service is made by overnight courier, “the date of . . . delivery to the overnight courier will be considered the date of service.” 37 C.F.R. § 2.119(c). Thus, a Certificate of Service indicates merely that the identified paper has been delivered to the carrier, not that it has actually been delivered to or received by the indicated recipient. The Certificate of Service filed by Katherine Klammer Madianos on October 12, 2009 stated that Ms. Madianos had deposited the Petition to Cancel with the U.S. Postal Service on October 8, 2009 for delivery to Mr. Melendez at 4280 Lindblade Drive, Apartment 104, Los Angeles, California 90066, Respondent’s correspondence address listed on the PTO’s Trademark Applications and Registrations Retrieval database (“TARR”) at

that time. As set forth in Ms. Madianos' declaration submitted herewith, Ms. Madianos did in fact so deposit the Petition to Cancel on October 8, 2009. Madianos Declaration paragraph 6. Thus, the Certificate of Service filed by Petitioner's attorney on October 12, 2009 was not "false."

D. Petitioner Notified the Board of Failed Service Within the Required Time.

Respondent implies in his Motion to Extend that Petitioner failed to notify the Board of the failure of Petitioner's original service attempt (deposited on October 1, 2009, by Ms. Madianos with Federal Express for delivery to Respondent at 4280 Lindblade Drive, Apartment 104, Los Angeles, California 90066 – the "Original Service Attempt") of the Petition to Cancel on Respondent within the required time period.

As set forth in 37 CFR § 2.111(b), "[i]f any service copy of the petition for cancellation is returned to the petitioner as undeliverable, the petitioner must notify the Board within ten days of receipt of the returned copy." In addition, as pointed out by Respondent in his Motion to Extend, the initial order issued by the TTAB in this case states as follows: "Plaintiff must notify the Board when service has been ineffective, within ten days of the date of receipt of a returned service copy or the date on which Plaintiff learns that service has been ineffective."

The Original Service Attempt was returned to Petitioner's attorney on October 13, 2009. Madianos Declaration paragraph 4. Until such date, neither Petitioner nor its attorney was aware that Petitioner's Original Service Attempt had been ineffective. *Id.* Petitioner informed the TTAB of the return of its

Original Service Attempt on Respondent on October 21, 2009, by filing a “Notice of Returned Mail” with the TTAB via ESTTA. Thus, the Notice of Returned Mail was filed eight days following the date on which the Original Service Attempt was returned to Petitioner’s attorney and Petitioner learned that the service had been ineffective, within the 10-day time limit required by law.

IV. CONCLUSION

The motion is moot because Respondent answered. In addition, Petitioner has complied with all service requirements and in fact has gone above and beyond what is required by the law in an effort to effect service on Respondent.

Dated: November 19, 2009

Respectfully Submitted,

/Kenneth G. Parker/

Kenneth G. Parker, Esq.
Teuton, Loewy & Parker LLP
3121 Michelson Drive, Suite 250
Irvine, CA 92612
949-442-7100
Fax: 949-442-7105
kparker@tlpfirm.com
Attorney for Petitioner

Katherine Madianos, Esq.
Attorney for Petitioner

DECLARATION OF KATHERINE KLAMMER MADIANOS

I, Katherine Klammer Madianos, declare as follows:

1. I am an attorney licensed to practice in Texas and California, counsel for PictureCode, LLC. I am an active member in good standing of the Bar of the State of Texas, and an inactive member in good standing of the Bar of the State of California. I make this declaration in support of Petitioner's Notice of Mootness of Respondent's Motion for an Extension of Time to Answer and Statement Correcting Factual Misstatement Made in Respondent's Motion to Extend Time (Petitioner's "Statement"). I make this declaration of my own personal knowledge and, if called as a witness, I could and would testify competently to the truth of the matters set forth herein.

2. On October 1, 2009 I filed via the TTAB's Electronic System for Trademark Trials and Appeals ("ESTTA") a Petition to Cancel registration no. 3,321,797 for DIGITAL NINJA on behalf of PictureCode, LLC, my client (Cancellation No. 92051532). I attached to such Petition to Cancel a Certificate of Service as to the service described in paragraphs 3 and 9 below.

Service on Mr. Melendez – First Attempt

3. On October 1, 2009, I deposited with Federal Express for overnight delivery, signature required, a copy of the Petition to Cancel for delivery to Juan B. Melendez III at the following address: 4280 Lindblade Drive, Apartment 104, Los Angeles, California 90066 (the "Original Service Attempt"). This address was then listed on the PTO's Trademark Applications and Registrations Retrieval

database (“TARR”) as the current address for Respondent. The Federal Express tracking number assigned to such package was 798116438185.

4. On October 13, 2009, I received notice that the Original Service Attempt had been returned and was being held for me at the Pak Mail located at 3112 Windsor Road #A Austin, TX 78703. The Federal Express tracking number for the return package was: 406050394988. I retrieved the package. Prior to such date, I was not aware that Federal Express had permanently abandoned its efforts to deliver the Original Service Attempt to 4280 Lindblade Drive, Apartment 104, Los Angeles, California 90066.

Service on Mr. Melendez – Second Attempt

5. On October 8, 2009, I entered the tracking number for the Original Service Attempt into the Federal Express tracking website and learned that such package had not yet been delivered. The reason stated was that “Customer not available or business closed – Access is controlled by customer.” The status was listed as “At local FedEx facility” in Marina del Rey, CA.

6. Believing that the Original Service Attempt had not yet been delivered due to the signature requirement on the package, on October 8, 2009, I delivered a second copy of the Petition to Cancel to the U.S. Postal Service for delivery via Express Mail (no signature required) to Mr. Melendez at 4280 Lindblade Drive, Apartment 104, Los Angeles, California 90066. The U.S.P.S. tracking number assigned to such package was EH 347043259 US.

7. According to the U.S. Postal Service website, this package was delivered to 4280 Lindblade Drive, Apartment 104, Los Angeles, California 90066 on October 9, 2009.

8. I filed a Certificate of Service as to this service attempt with the TTAB via ESTTA on October 12, 2009 (ESTTA310942).

Service on Mr. Chan – by Express Mail

9. On October 1, 2009, I deposited with the U.S. Postal Service a copy of the Petition to Cancel for delivery via Express Mail to Mr. Thomas T. Chan at the following address: P.O. Box 79159, Los Angeles, CA 90079-0159. This address was and is listed on Mr. Chan's law firm's website (www.chanlaw.com) as the mailing address for his firm. The Express Mail tracking number assigned to such package was EH 494940425 US. According to the U.S.P.S website, this item was "delivered at 10:15 AM on October 5, 2009 in LOS ANGELES, CA 90015. The item was signed for by T CHAN."

10. Mr. Chan had contacted me by phone and by email several times prior to such date in his capacity as counsel for Respondent. Thus, although Mr. Chan was not listed as Respondent's attorney of record on TARR, I sent Mr. Chan a copy of the Petition to Cancel.

Delivery to Mr. Chan by e-mail

11. On October 1, 2009, shortly following my filing of the Petition to Cancel detailed in paragraph 2 above, I received a phone message from Mr. Chan requesting that I call him the following day. In such message Mr. Chan made no indication that he was aware that we had filed the Petition to Cancel. As such, at

approximately 1:58 p.m. Central Standard Time on October 1, 2009, I sent an email to Mr. Chan at the following email address: thomas.chan@chanlaw.com, to which I attached a copy of the Petition to Cancel. I had received emails from Mr. Chan using this address and sent emails to Mr. Chan at such address on several occasions previously. I have received no indication that my e-mail to Mr. Chan of October 1, 2009 was not delivered.

12. On October 2, 2009 I had a phone conversation with Mr. Chan. In such phone conversation, Mr. Chan indicated that he was aware that we had filed the Petition to Cancel his client's DIGITAL NINJA mark.

I declare under penalty of perjury that the foregoing is true and correct.
Executed this 19th day of November, 2009.

/Katherine K. Madianos/

Katherine Klammer Madianos

Certificate of Service

Pursuant to C.R.F. § 2.111, I hereby certify that a true and correct copy of the foregoing PETITIONER'S NOTICE OF MOOTNESS OF RESPONDENT'S MOTION FOR EXTENSION OF TIME TO ANSWER; STATEMENT CORRECTING FACTUAL MISSTATEMENTS MADE IN RESPONDENT'S MOTION TO EXTEND TIME FOR ANSWER was served, via overnight courier, on Respondent Juan B. Melendez III, at the following address:

2008 Grant Ave #1
Redondo Beach, CA 90278

/Kenneth G. Parker/

Kenneth G. Parker, Esq.
Attorney for PictureCode, LLC